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NEIFELD REF.: CAT/29US-SCROCO

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: Scroggie et al.

USPTO CONFIRMATION CODE: 5333

SERIAL NO: 09/401,939

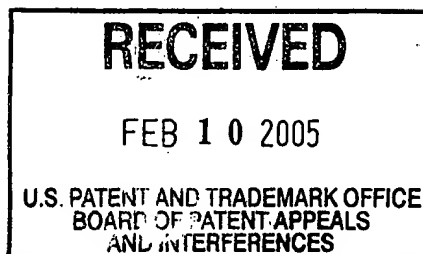
APPEAL NO.: 2004-0989

FILED: 9/23/1999

EXAMINER: Stephen Gravini

GROUP ART UNIT: 3622

FOR: System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network



BOX STOP APPEAL BRIEF - PATENTS

ASSISTANT COMMISSIONER FOR PATENTS

P.O. BOX 1450

ALEXANDRIA, VA 22313-1450

37 CFR 41.52 REQUEST FOR REHEARING

Sir:

In response to decision on appeal mailed November 22, 2004, please consider the following request for rehearing.

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REMARKS

Pursuant to 37 CFR 41.52, the appellants (herein after "T" or "we") respectfully set forth below with particularity the points believed to have been misapprehended or overlooked in rendering the decision in this appeal.

I. Summary of Decision

The panel (herein after "you") stated that you sustained the rejection of claims 32-70 for obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469. See Decision page 18 lines 10-12. You also stated that you sustain a provisional rejection of claims 32-70 over copending application Serial No. 09/567,274, based on obviousness-type double patenting. See Decision page 19 lines 20-22.

II. You Are Not Authorized to "Sustain"; You are Authorized to "Affirm"

As an initial matter, your decision states that you "sustain" [ed] certain rejections. See Decision page 18 lines 10-12 and decision page 19 lines 20-22. You are not authorized to "sustain." You are authorized to "affirm." 37 CFR 41.50. Appellant assumes below that when you say that you "sustain" you mean that you "affirm."

III. With Respect to the Improper Rejection of Claims 32 -70 Over Related Case 09/567,294, You Overlooked and Misapprehended Several Points

A. You Overlooked the Fact that the Examiner Presented a New Ground of Rejection in the Examiner's Answer

You overlooked the fact that the examiner presented a new ground of rejection in the Examiner's Answer. In the final office action, the examiner rejected claims 32-70 under 103(a) as being obvious over copending US Patent Application 09/567,274. The appellant appealed from the final rejection, not the Examiner's Answer.

An examiner cannot include a new ground of rejection in an answer (The answer was mailed 8/25/2003, so it is subject to the old rule 37 CFR 1.193). 37 CFR 1.193(a)(2).

You overlooked the fact that the examiner presented a new ground of rejection, in the

answer, by rejecting in the answer claims over application 09/567,274 for provisional obviousness type double patenting. The examiner did not make this provisional obviousness-type double patenting rejection over application 09/567,274 prior to appeal. The Appellants Brief was directed to the final rejections. The legal test for 103 and double patenting rejections differ. Accordingly, it is improper for you to address the alleged ground of unpatentability of double patenting. Therefore, you should revise your decision.

B. You Misapprehended Your Authority by Affirming a Rejection not Imposed by the Examiner Before the Close of Prosecution; You do not have Jurisdiction to Affirm a Rejection not Under Appeal

I submit that you misapprehended an important point of law regarding your authority by concluding that you affirmed rejections of claims 32-70 over 09/567,274 when you in fact entered new grounds of rejections for those claims. This is an important point of law because we have no recourse to address your de facto new ground of rejection if it is characterized as an affirmation of the examiner's after final improper new grounds of rejection. 37 CFR 41.52(a)(2).

You stated that, while the examiner indicates the rejection is based on "prior art" in stating that the rejection is under 35 USC 103, it is clear from the examiner's explanation at the bottom of page 15 in the answer, that the rejection is really a provisional rejection based on obviousness-type double patenting. Decision page 4 footnote 1.

However, the examiner's grounds for rejection was not based upon obviousness type double patenting, it was a 103(a) rejection. Only in the answer, on page 15, did the examiner impose an obviousness-type double patenting rejection. A new grounds of rejection is improper in an examiner's answer. Therefore, you have misapprehended your authority by affirming a rejection not timely imposed by the examiner.

You may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. 37 CFR 41.50(a)(1). As stated above, the Examiner's Answer was mailed 8/25/2003, as such it is subject to the old rule 37 CFR 1.193. 37 CFR 1.193(a)(2) states that an examiner must not include a new ground of rejection in an answer. You affirmed the examiner's new ground of rejection, which you are not entitled to do.

Therefore, you should reverse the original timely provisional 103(a) rejection over 09/567,274, since the examiner clearly admitted in the answer that the 103(a) rejection was improper.

C. You Overlooked the Fact that the Examiner Admittedly Failed to Make a Prima Facie Case of the 103(a) Rejection over Application 09/567,294

You overlooked the fact that the examiner did not make a prima face case when he rejected claims 32-70 under 35 USC 103(a) as being obvious over copending application 09/567,294.

To establish a prima facie case the examiner must cite to references that are prior art. A reference is a patent or publication cited to show that all or part of the invention for which a patent is sought was in the prior art, either more than a year before the filing date to which the applicant is entitled, in which case it is a "statutory bar" and cannot be sworn back of, or before the applicant's date of invention. See In re Stempel, 241 F.2d 755, 113 USPQ 77, 81 (C.C.P.A. 1957).

In the instant case, application 09/567,294 was not available as prior art because it was not a patent or a publication. Therefore, the examiner failed to establish a prima facie case because the examiner failed to provide a reference which was timewise available, and that teaches the claimed invention. Thus you should reverse the 103 grounds for rejection.

Furthermore, you admit that the examiner has not made a prima facie case by stating that "it appears to be the examiner's position..." See decision page 18 lines 18-24. You misapprehend your authority by stating reasons why the modification would have been obvious, when you are only allowed to affirm or reverse. You state, "...and that the instant claims would have been obvious thereover, especially since the instant claims appear to be broader in scope." See Decision page 18 lines 18-24. In fact, the examiner does not provide a statement of obviousness in his rejection. Thus, it is requested that this rejection is reversed.

D. In Fact, You Re-Characterized the Examiner's Rejection and Thus Admitted that the 103(a) Rejection was Improper

You misapprehended your authority because instead of addressing the 103(a) rejection

imposed by the examiner or addressing the fact that the examiner added a new rejection in the Examiner's Answer, you re-characterized the examiner's 103(a) rejection as a provisional obviousness type double patenting rejection.

You state, "While the examiner indicates the rejection is based on "prior art" in stating that the rejection is under 35 USC 103, it is clear from the examiner's explanation, especially, at the bottom of page 15 in the answer, that the rejection is really a provisional rejection based on obviousness-type double patenting." Decision page 4 footnote 1.

By recharacterizing the examiner's rejection, you admit that the rejection under 103(a) is improper. Because the rejection under 103(a) is improper and that is the rejection that was imposed by the examiner, the rejection of claims 32-70 over application 09/567,274 should be reversed.

IV. Conclusion

For the reasons state above, we respectfully submit that upon rehearing and in view of the foregoing reasoning you revise your decision to reverse the provisional rejections of claims 32-70 over 09/567,294.



DATE

Respectfully Submitted,



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NAC

Printed: January 21, 2005 (4:04pm)

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Application No. 09/401,939

Attorney Docket No. CAT/29US-SCROCO

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on 21 January 2005

Date

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Richard A. Neifeld

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Registration Number, if applicable

703-415-0012

Telephone Number

The following papers are included in this facsimile transmission:

Transmittal Letter/Authorization to Charge Deposit Account (In Duplicate)

37 CFR 1.321 Terminal Disclaimer Over A Patent By Attorney (2 pages)

37 CFR 41.52 Request for Rehearing (6 pages)

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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TRANSMITTAL LETTER AND AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

ASSISTANT COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

RE: Attorney Docket No.: CAT/29US-SCROCO
Application Serial No.: 09/401,939
Filed: 9/23/1999
Title: System and Method for Providing Shopping Aids and Incentives to
Customers Through a Computer Network
Inventor: Scroggie et al.
Group Art Unit: 3622
Examiner: Gravini

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SIR:

Attached hereto for filing are the following papers:
37 CFR 1.321 Terminal Disclaimer Over A Patent by Attorney (2 pages)
37 CFR 41.52 Request for Rehearing (6 pages)

The Commissioner is hereby authorized to charge \$130.00 To Deposit Account
Number 50-2106. A duplicate copy of this sheet is enclosed.

The Commissioner is hereby authorized to charge any fees which may be required, or
credit any overpayment, to Deposit Account Number 50-2106.

Respectfully Submitted;

DATE

Richard A. Neifeld, Ph.D.
Registration No. 35,299
Attorney of Record

Printed: January 21, 2005 (4:26pm)

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